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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/728,653 | 12/01/2000 | Wei Han | PH-7118 | 5964 |

23914 7590 09/24/2003

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EXAMINER

LUKTON, DAVID

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1653

DATE MAILED: 09/24/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,653

Applicant(s)

HAN, WEI

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7,12,16,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7,12 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Pursuant to the directives of paper No. 14 (filed 7/3/03), claims 3, 21, 22 have been amended. Claims 3-7, 12, 16, 21, 22 are pending.

Claims 3-7, 12, 16 are examined; claims 21-22 remain withdrawn from consideration. Applicants' arguments filed 7/3/03 have been considered and found persuasive. The rejection of claims 1-2 is rendered moot by the cancellation of these claims.

*

Claims 3-7, 12, 16 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 3 and 5, the term *carbocycle* is spelled as "carbocyle".

*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-4 are rejected under 35 U.S.C. §102(b) as being anticipated by Takeuchi (USP 5,162,500).

Takeuchi discloses (col 2, line 25+) compounds of formula I; examples of the compounds

are recited in table 2 (col 31, line 1+). Compound #2 is encompassed by instant claim 3 when the substituent variables correspond as follows:

R⁹ = carboxybenzyloxy
A² = a bond
A³ = a bond
A⁴ = an amino acid
A⁵ = an amino acid
R¹ = ethyl
R² = hydrogen
R¹⁰ = alkyl
Q² = -X-NH-Z
X = -CO-
Z = an amino acid residue.

Thus, the claims are anticipated.

*

Claims 3-4 are rejected under 35 U.S.C. §102(b) as being anticipated by Bastos, Margarita (*Proceedings of the National Academy of Sciences* **92**(15), 6738-42, 1995).

Bastos discloses (table 4, page 6741, col 1) the following compound:

Z-Ile-Glu-Pro-Phe-CO-Glu-Asp-Arg-OMe

These claims are anticipated when the substituent variables are as follows:

R⁹ = carboxybenzyloxy
A² = a bond
A³ = an amino acid
A⁴ = an amino acid
A⁵ = an amino acid
R¹ = benzyl

R^2 = hydrogen
 R^{10} = $-\text{CH}_2-\text{CH}_2-\text{COOH}$
 Q^2 = $-\text{X}-\text{NH}-\text{Z}$
 X = $-\text{CO}-$
 Z = A7-A8-A9, wherein A7 is a bond, and A8 - A9 are amino acid residues.

*

No claim is allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

D. Lukton 9/22/03

Christopher S. F. Low

CHRISTOPHER S. F. LOW
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